REMARKS

Upon entry of the above amendments, claims 17-41 will be pending.

In view of the above claims, including unamended claims 17-39 and newly submitted claims 40 and 41, Applicants traverse the rejections in the outstanding Office Action and request reconsideration of the same.

The Office Action dated January 24, 2007 rejects the claims under 35 U.S.C. § 103(a) as being unpatentable over Ibarra (US Patent No. 6,119,097) in view of Eder (Published Application No. 2001/0034628). Ibarra has been of record in this Application for quite some time, although it is listed on the PTO Form 892 accompanying the Office Action.

This Office Action is in response to Applicants' Response filed by Applicants on October 23, 2006. That Response followed a personal interview attended by the Examiner, by Supervisory Patent Examiner Joseph Thomas, and by the undersigned.

Applicants' representative noted in that personal interview that Applicants' representative understands the intention of Examiners to give claims their broadest reasonable interpretation, considering the plain meaning of the terms in the claims, and also considering those claim terms in view of the specification, as would one of ordinary skill in the art. With this in mind, Applicants' representative further explained in the personal interview that Applicants' representative had gone to great length to clarify the language in the claims, so that certain terms in the claims would not be misconstrued in a manner not intended by Applicants, resulting in a rejection.

If at any point it becomes apparent to the Examiner that Applicants and the Examiner are attributing different meanings to claim language, Applicants ask that the Examiner contact the undersigned by phone, to discuss whether minor changes to the claims can resolve such a difference.

The references applied to reject the claims, Applicants respectfully submit, considered alone or combined as asserted (assuming arguendo such a combination were proper) are lacking limitations recited throughout the claims, and are even lacking numerous limitations recited in each of independent claims 17, 35, 37, 40, and 41.

Applicants consider that the Examiner may be taking the position that all the noted claim limitations (asserted by Applicants to be missing from the applied references, as modified) are

either inherently included or would have been obvious. If this is the case, Applicants submit that the missing claim limitations are quite substantial and numerous – to the point that the rejection is either (i) an improper use of Applicants' own disclosure in hindsight or (ii) insufficiently explained and supported.

Accordingly, should the rejections be maintained, Applicants implore the Examiner to further articulate and clarify the manner in which each and every limitation of each claim (particularly each of the pending independent claims) is indeed specifically disclosed or otherwise suggested by the references as combined.

Applicants support the Patent Office taking precautions before allowing claims, to help make the resulting patent of the best quality. However, sometimes the evidence (in this case, a combination of references) is lacking to such an extent that the rejections become more than precautionary – they become an outright barrier to patent protection, an approach contrary to the very mandate of the Patent Office, to examine and grant patents.

While as summarized above (and as further elaborated below), Applicants traverse the rejections, Applicants nonetheless want to try to move this Application forward. Thus, Applicants have submitted new claims 40 and 41 (broadened in some respects), each of which more specifically recites certain limitations (e.g., they each recite that the data receive mechanism is configured to receive data units via a network connection, from source storage...), which may give the Examiner more comfort in deciding to allow those claims.

However, Applicants feel strongly, after much reflection, both before the personal interview and again now after receiving and reviewing the current Office Action, that the all of claims 17-39 (and now, new claims 40 and 41) are patentable over any references of record, including the references applied now in the outstanding Office Action.

As Applicants emphasized in the previous Response dated October 23, 2006, the limitations recited in the claims relate to features that are very important to the information technology field. The ease with which a system can be configured, e.g., a human resources performance management system, can be quite important.

People in the workforce are too familiar with the frustrations and time demands of hard-to-configure software. Even tasks as simple as creating a new spreadsheet in Microsoft Excel® or creating a new letterhead template using Microsoft Word® can be daunting to some computer

users. So, when a worker (not a programming expert) is asked to configure the company's performance management system to implement a new performance metric, a user-friendly configuration interface can transform a once arduous task into a relatively easy one.

The claims recite features that address, among other issues, this significant user configurability problem. The absence of so many claimed limitations in the references individually (and as combined), is notable.

<u>The Claims</u>

Each of the independent claims, i.e., claims 17, 35, 37, 40, and 41, recites limitations relating to the following features:

(a) *Coining a name of the metric.* User input of a coined name for a custom performance metric to be defined. This input is presented on a computer screen.

(b) *Data unit type selection.* User input of selected type terms. This input is presented on a computer screen.

(c) *Receipt of at least one defined mathematical operation.* User input of at least one defined mathematical operation. This input is presented in a computer screen.

(d) *Association of these inputs with each other.* The coined term is associated with the selected types and with the defined mathematical operation.

<u>The Rejection</u>

The Office Action asserts that the claims are obvious and therefore unpatentable based on Ibarra in view of Eder.

<u>The Primary Reference (Ibarra)</u>

In making the rejection, the Office Action first directs Applicants attention to Ibarra, column 5, lines 1-5, column 6, lines 41-48.

Ibarra is directed to a system for quantification of human performance factors. The system envisions a situation where performance metrics and other standards were already created before the user encounters the system. Ibarra, col, 6, lines 11-12. Managers enter the standards in a standards check-up data entry screen (in Fig. 3), Ibarra, col. 6, lines 45-46, and enter appraisal summary information in a performance appraisal summary display (in Fig. 5), Ibarra, col. 8, lines 22-23.

Thus, it is apparent that Ibarra does not concern itself with defining new performance metrics, nor does it deal with automatically calculating any performance metrics.

Applicants thus question the relevance of this reference to the invention as recited, e.g., in the independent claims of the present application.

The Secondary Reference (Eder)

As noted by the Examiner in the Office Action, starting in the paragraph at the bottom on page 2 of the Office Action, Ibarra (the primary reference) does not teach or suggest any of the claimed limitations (a)-(d) noted above. However, the Examiner asserts that such limitations are "well known", citing Eder.

The Examiner refers to the following parts of Eder: page 3, paragraph 27; page 5, paragraph 48; page 10, paragraph 82; and page2, paragraph 19.

A reading of these sections of Eder reveals that Eder teaches the following points: (1) a data dictionary table 149 provided in a system for determining the value of a company, (2) an account structure and data dictionary 902 as shown in Fig. 4; and (3) a process step (step 205) where a user is prompted to input account structure and data dictionary information in the process shown in Fig. 5A.

Suppose that Eder teaches providing a data dictionary table in an IT system for valuing a company, and that Eder further teaches prompting a user to input data dictionary information.[1] This is quite vague, and does not teach or suggest the limitations recited in the claims.

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[1] Eder states, for example, at paragraph 82 on page 10, the following:

> "the software in block 205 interacts with an account structure and data dictionary data window (902) that prompts the user for any input that is required to define data fields for the extracted data dictionaries and the data dictionary of the application software of the present invention. This input is also saved to the data dictionary table (149). The software in block 205 also prompts the user (20) via the account structure and data dictionary data window (902) for information that edits or defines the account structure used in the financial system databases. It is common practice for account numbers to have several segments where each segment represents a different set of sub groups as shown below in Table 13."

Even assuming, arguendo, that Eder teaches providing a data dictionary, and that it would have been obvious to provide a data dictionary (the type taught by Eder) in the Ibarra system, the resulting system still lacks recited limitations of the independent claims in this application.

DISCUSSION

I.

Each of the independent claims

Each of claims 17, 35, 37, 40, and 41 recites limitations requiring the receipt of at least one defined mathematical operation, limitations which are neither taught nor suggested by the references, alone or in any proper combination.

For example, Eder lacks any teaching or suggestion relating to the input of a defined mathematical operation via an input presented in a computer screen. Eder further lacks any teaching or suggestion of an association of a defined mathematical operation with a coined name of a performance metric as well as with selected data unit types, limitations also required by each of the independent claims. Ibarra is also lacking these limitations. Therefore, any combination of these two references, proper or not, still lacks these limitations.

The references of record, including Ibarra and Eder, fail to individually, or in any proper combination, teach the combination of limitations as recited in any of the independent claims in the present Application. Therefore, Applicants submit that all of the claims pending in the present Application are patentable under 35 U.S.C. § 102 and § 103.

II.

Claim 17, in more detail

Claim 17 of the present Application recites, among other limitations, a metric name input presenter. The metric name input presenter is preconfigured to present, on a computer screen, a metric name input field.

The Examiner states that Eder teaches that a user can input information required to define data fields for extracted data dictionaries, and for a data dictionary of application software, and makes reference is made to Eder, page 10, paragraph 82, lines 3-6. Applicants do not understand how the (Eder disclosed) prompting of "the user for any input that is required to define data

fields for the extracted data dictionaries and the data dictionary of the application software" (Eder, page 10, paragraph 82, lines 3-6) could be the same as the currently claimed limitation of presenting, on a computer screen, a metric name input field.

This teaching in Eder further fails to teach that the presentation of such a field is preconfigured, another limitation, e.g., of claim 17.

This teaching in the Eder reference further fails to teach that the presented metric name input field receives a flexible textual character term, a limitation recited, e.g., in claim 17 (not recited in claim 41).

This teaching in Eder further fails to teach that the input term is coining a name for a custom performance metric to be defined, another limitation of the claims, e.g., of claim 17.

This teaching in Eder further fails to teach that the term is associated (as recited, by a data association mechanism, e.g., in claim 17) with the selected types and with at least one defined mathematical operation.

This teaching in Eder further fails to teach that the selected types are received by the a data unit type input field, presented by a data unit type presenter, another limitation of, e.g., claim 17. The selected types with which the coined term is associated are to be collected and used to formulate the custom performance metric. This is also not taught by the Eder reference.

The noted Eder teaching further fails to teach that at least one defined mathematical operation, with which the coined term is also associated, was received from user input by a recited operator input presenter, another limitation, e.g., of claim 17.

Notably, the Office Action states that Ibarra does not expressly teach essentially all of the second, third, fourth, and fifth indented portions of claim 17. In addressing this majority of limitations in the claim, the Office Action states "that these features are well known in the art as evidenced by Eder."

The Examiner states that Eder teaches utilizing different valuation methodology, teaches an application database for storing user input, extracted information and system calculations. The Office Action further states that Eder teaches a data dictionary window and prompting the user for any input required to define data fields.

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Curiously, these statements made in the Office Action, in the first full paragraph on page 3 of the Office Action, do not address each of the above-described limitations, e.g., recited in independent claim 17.

Even assuming, arguendo, that such the asserted modification of the Ibarra system would have been proper, the resulting modified system still fails to include all of the limitations recited in independent claim.

III.

A note regarding whether Eder is a prior art reference

Applicants note that Eder is applied as a reference under § 102(e). It is possible that the published application of Eder includes subject matter that was added to the application after the effective filing date of the present Application. For example, the Eder published Application is a continuation-in-part of Application No. 09/135,983, filed August 17, 1998, which is a continuation in part of another Application, and so on. Therefore, Applicants do not acknowledge whether or not the Eder reference is prior art per § 102, but rather make the arguments herein assuming (arguendo) that it is a prior art reference.

CONCLUSION

In view of the foregoing, Applicants submit that each of the claims in the present Application is patentable under 35 U.S.C. §§ 102 and 103. Applicants request reconsideration and allowance of the present Application. A Notice to that effect is earnestly solicited.

Should the Examiner have any questions regarding the present Application, the Examiner is requested to contact the undersigned at the below-listed telephone number.

Respectfully submitted,

Dated: _5/24/07_

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